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CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP			TANG, KAREN C	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/635,598	KAMINSKY ET AL.
	Examiner	Art Unit
	Karen C. Tang	2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 May 2007.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

- This action is responsive to the amendment and remarks file on 5/2/07.
- Claims 1-24 are amended and are for further examination.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 5/2/07 have been fully considered but they are not persuasive.

Applicant argued that

(1) As apparent from this teaching, Spear does not teach forwarding a notification of impairment to deliver a message to a sender of the message. Instead, Spear teaches that the message is merely sent back to the original sender. Absent from Spear is an explicit teaching that the sending an e-mail back to the original sender constitutes a notice that delivery to the intended recipient has become impaired.

(2) Claims 7, 17 and 8, 18 respectively recite the claimed "detecting an impairment" includes concept of consulting/probing for information regarding the claimed "said respective servers." In the statement of the rejection, the Examiner referred to lines 17-22 of paragraph [0039] within Shuster to teach these limitations. For ease of reference, the Examiner's cited passage is reproduced below: Then, the destination mail server would obtain the delivery code list belonging to the root address, determine whether the message address contained a valid delivery code, and if so, place the message in the addressee's inbox folder in a subdirectory (folder) belonging to the corresponding delivery code. 4 Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir.

1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990). At the outset, Applicants note that the Examiner's cited passage is not relevant to the limitations at issue. Shuster does not teach "consulting a data store of state information for selected ones of said respective mail servers" (i.e., claims 7 and 17) or "probing selected ones of said respective mail servers to detect said impairment (i.e., claims 8 and 18). Instead, Shuster teaches checking whether a message address contains a valid delivery code, which is not related to the statement information and/or impairment of the claimed respective servers. Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 7-8 and 17-18 under 35 U.S.C. § 103 for obviousness based upon Spear in view of Shuster is not viable and, hence, solicit withdrawal thereof.

(3) Applicants respectfully submit that Spear is non-analogous prior art with Eguchi on page 6 of previous Office Action that cannot be applied against the claimed invention. Whether a prior art reference is from a nonanalogous art involves (a) determining whether the reference is within the same field of endeavor and (b) determining whether the reference is reasonably pertinent to the particular problem with which the invention is involved.<sup>6</sup> If the prior art is outside the inventor's field of endeavor, the inventor will only be presumed to have knowledge of prior art that is reasonably pertinent to the problem being addressed.<sup>7</sup> The Examiner is also charged to consider "'the reality of the circumstances' ... in other words, common sense" to determine what field a person of ordinary skill in the art would reasonably be expected to look.<sup>8</sup> With regard to this issue, the Examiner is also referred to M.P.E.P. § 2141.01, entitled "Analogous and Nonanalogous Art." Whereas the claimed invention is directed to a mail server that detects electronic mail delivery failures in a mail delivery system, Spear is directed to the

automation of reducing unsolicited email. Thus, the claimed invention and methodology of Spear are not within the same field of endeavor. Furthermore, the claimed invention is directed to, in part, solving the problem of how to notify a sender as to the failure of an e-mail server to deliver an e-mail to a targeted recipient. The teachings of Spear, however, are not reasonably pertinent to solving this problem. Thus, Spear is non-analogous prior art that cannot be applied against the claimed invention.

(4) On pages 6 and 7 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been led to modify Spear in view of Generous to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed. Applicants respectfully submit that the Examiner's proposed rationale to modify Spear in view of Generous would not have led one having ordinary skill in the art to combine the applied prior art so as to arrive at the claimed invention. The Examiner has failed to set forth a reasonable explanation as to why one having ordinary skill in the art would want to format a detailed notification to a sender of an e-mail when Spear teaches that the "nature of said impediment" is that Spear considers the e-mail to be unwanted or junk e-mail. Moreover, Applicants are entirely unclear as to what purpose would be served to prepare a notification that includes "both a statement of said impairment and an estimate of when normal mail delivery service can resume" or "both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages." In the first instance, the normal mail delivery serve will not resume because the e-mail is considered junk e-mail. In the second instance, the alternative e-mail address would provide no purpose since this alternative e-mail address would now receive the junk e-mail. Therefore, for the reasons stated above, Applicants respectfully submit that the

imposed rejection of claims 12-14 and 22-24 under 35 U.S.C. § 103 for obviousness based upon Spear in view of Generous is not viable and, hence, solicit withdrawal thereof.

(5) On pages 7-9 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been led to modify Spear in view of Katagiri and Generous to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed. Applicants incorporate herein the arguments previously presented within regard to the rejection of claims 12-14 and 22-24. The Examiner has not put forth a rationale explanation as to why one having ordinary skill in the art would create a notification that includes "an estimated time when said delivery will no longer be impaired; and an alternate e-mail address with which said selected ones of said senders can retransmit said messages to corresponding intended recipients" when the e-mail that is sent is considered to be junk e-mail. Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claim 2 under 35 U.S.C. § 103 for obviousness based upon Spear in view of Katagiri and Generous is not viable and, hence, solicit withdrawal thereof.

Examiner respectfully traversed the argument –

In reply to argument (1):

What is being claimed is that the delivery to said intended recipients is impaired. This is simply read, as the email is not being delivered to the recipient.

Spear teaches that when the characteristics of the email sent by the sender was not proper, the email was being sent back, which constitutes as "the email is not being delivered to the recipient.

Applicant has to understand that according to the broadly claimed limitation “notifying one of said senders,.etc. ”, applicant did not claimed the type of notification is being sent to the sender, nor did applicant claiming how to notify the sender when the delivery to said intended recipients has become impaired. Therefore, from Spear, sending back the email to the sender constitutes the action of “notifying”, and the email is only being sent back when it is determined the delivery to the recipients has become impaired (email fails to satisfied the characteristics/filter rules, e.g., recipient address was not correct, refer to Spear, 0028. applicant never argued what is meant by “impaired”, therefore, it is being interprets as recipients ). Therefore, Spear reads on applicant’s limitations.

In reply to argument (2): Again, due to the broadly claimed language, “a data store of state information for selected ones of said respective mail servers to call an already identified impairment”,

Shuster disclosed there is at least one of mail server in the system (refer to 0033, lines 7), and by having the delivery codes (state information in the data store), refer to Col 38, Lines 1-2, which helps in term of deliver to the appropriate destination. Shuster disclosed that each mailboxes 104a-d in Fig 1, is similar to network mail servers, each of which is provided with a unique network address through a registry system, Each server then may maintain a separate registry of unique account names. Each account name plus a mail server address comprises a fully qualified address for identifying a particular addressee. Each account name plus a mail server address comprises a fully qualified address for identifying a particular addressee according to a mail sender’s delivery intention, refer to 0034, Lines 7-12. Thus, it is indicated that by having the delivery code along with the root address, it selected appropriate routes to the appropriate mail

box (mail server), and then delivered to the destination. Thus, it is relevant to what is indicated in the claim limitation.

In reply to argument (3): Both Spear and Eguchi focus their system on improving emailing system. What Eguchi's system has functionality that can improve Spear's system, for example, it has capability of providing confirmation when the email has been successfully received, refer to 0017, lines 4-11, or the missing electronic mails, refer to 0035, Lines 7, by having these capabilities, the system is able to detect the fault within the emails transmission.

In reply to argument (4): Spear not only teaches "nature of said impediment" is that Spear considers the e-mail to be unwanted or junk e-mail, but also errors on sender's IP address, MAC address, sender's address, recipient address, number of recipients, number of invalid recipients, etc. Any of these errors will trigger the mailing system to either discarded, stored, or sent back the email back to the original sender (refer to 0028-0030). Therefore, by combining with Generous, it provides the need to formatting the notification that comprises statement of the impairment and an alternative email address for use in retransmission. By modified the Spear's invention, it can improve the system by providing faster time and knowledge of the status of email, in order to retransmit the important message to the proper destination.

In reply to argument (5) Spear not only teaches "nature of said impediment" is that Spear considers the e-mail to be unwanted or junk e-mail, but also errors on sender's IP address, MAC address, sender's address, recipient address, number of recipients, number of invalid recipients, etc. Any of these errors will trigger the mailing system to either discarded, stored, or sent back the email back to the original sender (refer to 0028-0030). Therefore, by combining with Generous, it provides the need to formatting the notification that comprises statement of the

impairment and an alternative email address for use in retransmission. By modified the Spear's invention, it can improve the system by providing faster time and knowledge of the status of email, in order to retransmit the important message to the proper destination.

***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Claim Rejections - 35 USC § 112***

Claims 1-4 are recites the limitation "said manager" in Claim 1, Lines 6. There is insufficient antecedent basis for this limitation in the claim (i.e., said manager in Claim 1, Lines 6 should have been "said notification manager")

Claims 5-14, are recites the limitation "said messages" in Claim 5, Lines 6. There is insufficient antecedent basis for this limitation in the claim (i.e., said messages in Claim 5, Lines 6, should have been "said e-mail messages")

Claims 15-24 have similar problem as Claims 5-14, correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 6, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by

Spear (US 2003/0149726).

1. Referring to Claims 1, 4, 5, and 15, Spear disclosed storing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers (refer to 0026, gateway comprising the mail queue); detecting an impairment to delivering said messages to said inboxes (refer to 0029, amount of damage a particular damage or unwanted messages in the queue, refer to 0029); identifying senders for selected one of said messages (refer to 0030, Lines 11-12); and forwarding a notification of said impairment to said identified senders (refer to 0030, Lines 11-12, sent back the original messages as a type of notification of said impairment).

2. Referring to Claims 6 and 16, Spear disclosed wherein said storing step comprises the step of queuing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers (refer to 0026).

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 8, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (US 2003/0149726) in view of Shuster (US 2002/0023135).

3. Referring to Claims 7, 8, 17, and 18, Spear disclosed wherein said detecting step comprises the step of consulting a data store of state information that already have identified impairment (refer to 0033).

Although Spear disclosed the invention substantially as claimed, Spear is silence regarding consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment.

Shuster, in an analogous art disclosed consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment (refer to 0039, Lines 17-22).

Hence, providing consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment disclosed by Shuster, would be desired for users to utilize due to the fact it can save loading time and efficiently eliminate junk mail from the mail system (refer to 0009).

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Shuster that efficiently improve the overall functionality of the system.

Claims 9, and 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (US 2003/0149726) in view of Eguchi (US 2001/0040694).

4. Referring to Claims 9 and 19, although Spear disclosed the invention substantially as claimed, Spear is silence regarding: wherein said detecting step comprises the steps of: attempting to transmit said messages; and, concluding the existence of an impaired state when said attempt fails.

Eguchi in an analogous art disclosed attempting to transmit said messages (refer to 0014); and, concluding the existence of an impaired state when said attempt fails (refer to 0014).

Hence, providing steps of detecting by concluding the existence of an impaired state by attempting to transmit said messages disclosed by Eguchi, would be desired for users to utilize due to the fact that (refer to 0009) it save time providing a kind of receipt from the recipients knowing that whether or not they can receive proper messages.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Eguchi that efficiently improve the overall functionality of the system.

Claims 3, 10, 11, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (US 2003/0149726) in view of Pearson et al hereinafter Pearson (US 2005/0235360).

5. Referring to Claims 3, 10, 11, 20 and 21, although Spear disclosed the invention substantially as claimed, Spear is silent regarding: wherein said step of identifying comprising the step of identifying only priority senders (refer to 0020).

Pearson, in an analogous art disclosed, wherein said step of identifying comprising the step of identifying only priority senders (refer to 0011).

Hence, providing step of identifying only priority sender disclosed by Pearson, would be desired for users to utilize due to the fact it eliminates non priority senders and saving processing time (refer to 0009).

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Pearson that efficiently improve the overall functionality of the system.

Claims 12, 13, 14, 22, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (US 2003/0149726) in view of Generous et al hereinafter Generous (US 20020120697).

6. Referring to Claims 12, 13, 14, 22, 23, and 24: although Spear disclosed the invention substantially as claimed, Spear is silent regarding:

wherein for each of said identified senders, formatting a notification comprising both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages; and, forwarding said detailed notification to said identified senders.

Generous, in an analogous art disclosed, wherein for each of said identified senders, formatting a notification comprising both a statement of said impairment and an alternate e-mail address (refer to 0372) for use in retransmitting a corresponding one of said messages (refer to 0341-0349); and, forwarding said detailed notification to said identified senders (0341-0349).

Hence, providing step of formatting a notification comprising both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages; and, forwarding said detailed notification to said identified senders disclosed by Generous, would be desired for users to utilize due to the fact it provides the fastest time and proper knowledge of how to retransmit the messages to the proper destination.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Generous that efficiently improve the overall functionality of the system.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spear (US 2003/0149726) in view of Katagiri et al hereinafter Katagiri (US 20020073364) in further view of Generous et al hereinafter Generous (US 20020120697).

7. Referring to Claim 2, although Spear disclosed the invention substantially as claimed, Spear is silence regarding: disclosed message generation logic programmed to format

notifications for said senders which indicates at least one of an estimated down time of said mail server; an estimated time when said delivery will no longer be impaired; and an alternate e-mail address with which said selected one of said senders can retransmit said messages to corresponding intended recipients.

Katagiri, in an analogous art disclosed message generation logic programmed to format notifications for said senders which indicates at least one of an estimated down time of said mail server (refer to 0076); an estimated time when said delivery will no longer be impaired (refer to 0065);

Hence, providing step of disclosed message generation logic programmed to format notifications for said senders which indicates at least one of an estimated down time of said mail server; an estimated time when said delivery will no longer be impaired disclosed by Katagiri, would be desired for users to utilize due to the fact that providing senders the additional information indicating the problem of the system in order to save time and allow users to think of alternative ways to perform further communication.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Katagiri that efficiently improve the overall functionality of the system.

although Spear and Katagiri disclosed the invention substantially as claimed, both in silence regarding: an alternate e-mail address with which said selected one of said senders can retransmit said messages to corresponding intended recipients.

Generous, in an analogous art disclosed an alternate e-mail address with which said selected one of said senders can retransmit said messages to corresponding intended recipients (refer to 0372).

Hence, providing step of formatting a notification comprising both a statement of said impairment and an alternate e-mail address for use in retransmitting a corresponding one of said messages; and, forwarding said detailed notification to said identified senders disclosed by Generous, would be desired for users to utilize due to the fact it provides the fastest time and proper knowledge of how to retransmit the messages to the proper destination. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Spear by including the features disclosed by Generous that efficiently improve the overall functionality of the system.

### *Conclusion*

**Examiner's Notes:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the

structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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SUPERVISORY PATENT EXAMINER